

Office Action Summary	Application No. 09/992,248	Applicant(s) KRULEVITCH ET AL.	
	Examiner Joseph S. Machuga	Art Unit 3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 32-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: ____. |

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-31, drawn to artificial vision system, classified in class 607, subclass 116.
 - II. Claims 32-39, drawn to a method of processing, classified in class 29, subclass 825.
 - III. Claims 41-56, drawn to a system for fabricating, classified in class 216, subclass 24.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II & III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case. The processes can be used to make a semiconductor chip.

3. During a telephone conversation with Mr. Edward E. Scott on February 10, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicant in replying to this Office action. Claims 32-56 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the barbs, hooks and tacks recited in claims 13, 23 and 30 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-21 and 25-31 are rejected under 35 U.S.C. 101 because the claims positively recite a part of the human body therefore it is directed to nonstatutory subject matter. Note for example phrases such as "contact said retina", "in said retina", "into an eye and to a retina", "connected to said retina" etc. that are used in the claims noted above. It is suggested that language such as "for contacting," (as in applicant's in Claim 1), "adapted to be attached," "for attachment to" or the like be used.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "said conductive leads" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Edell et al #5476494.

10. Edell et al disclose a low pressure neural implant having a substrate 24 composed of a flexible and soft polymer (column 5, line 62+) and electrodes 28 embedded therein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 4, 5, 14, 15, 17-21, 24-28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al in view of Pinchuk #5741331.

12. Edell et al disclose a low pressure neural implant having a substrate 24 composed of a flexible and soft polymer (column 5, line 62+) and electrodes 28 embedded therein. Not disclosed by this reference is the limitation that the polymer is a stretchable polydimethylsiloxane.

13. Pinchuk teaches (note column 2, lines 55+) that polydimethylsiloxane while not perfect for all applications is widely used in medical implants because it's an extremely stable elastomer.

14. Given these disclosures, It would have been obvious to one of ordinary skill in the art to use polydimethylsiloxane in Edell et al's implant given Pinchuk et al's disclosure that the material is old and well known and extremely stable, characteristics desirable in an implant.

15. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al. It is considered obvious that the invention disclosed by Edell et al is designed to transmit some form of visual image to the implant recipient given the structure and placement of the electrodes and the disclosed function of stimulating retinal neural cells.

16. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al in view of Kuzma # 6038484.

17. Kuzma teaches the use of points or barbs in an implant to help maintain it in position. To add this feature to the electrodes or other component of Edell et al's device would have been obvious to one of ordinary skill in the art given Kuzma's teaching that such a feature is desirable to help secure the implant in place.

18. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al in view of Kuzma #6078841.

19. Kuzma teaches the use of LSR in a medical implant. The material would allow molding techniques to take place. Given this reference it would have been obvious to one of ordinary skill in the art to use LSR in place of the silicone material in Edell et al to make manufacturing of the implant easier.

20. Claims 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al in view of Pinchuk as applied to claim 18 above, in further view of Humayun et al.

21. Humayun et al disclose an implant that includes a video camera 20 and neuron stimulator 22. The reference is designed to transmit a visual signal to the patient.

22. Given this teaching it would have been obvious to one of ordinary skill in the art to add a video camera to the proposed combination to increase the quality of the image conveyed to the patient given Humayun et al's teaching that it is old and well known in the art to do so.

23. Claims 23 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edell et al in view of Pinchuk as applied to claims 18 and 25 above, in further view of Kuzma #6038484.

Kuzma teaches the use of points or barbs in an implant to help maintain it in position.

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To add this feature to the electrodes or other components of Edell et al's device would have been obvious to one of ordinary skill in the art given Kuzma's teaching that such a feature is desirable to help secure the implant in place.

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph S. Machuga whose telephone number is 703-305-6184. The examiner can normally be reached on Monday-Friday; 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela D Sykes can be reached on 703-308-5181. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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